

REMARKS

The present application was filed on March 7, 2001 with claims 1-16. Claims 1-16 remain pending. Claims 1, 8, 15 and 16 are the pending independent claims.

In the outstanding final Office Action dated March 9, 2005, the Examiner rejected claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,421,346 (hereinafter "Itoh") in view of U.S. Patent No. 6,678,741 (hereinafter "Northcutt").

With regard to the rejection of claims 1-16 under 35 U.S.C. §103(a) as being unpatentable over Itoh in view of Northcutt, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness, in that the collective teachings of Itoh and Northcutt do not meet the claim limitations, there is no demonstrated motivation for the proposed combination, and there is no reasonable expectation of success.

Applicants initially assert that the collective teachings of Itoh and Northcutt, assuming for purposes of argument that these references are combinable, fail to disclose techniques described in independent claims 1, 8, 15 and 16 of the present invention.

Independent claims 1, 8 and 15 recite that at least one message is received in the first device from a second device of the communication system. It is determined if the protocol version of the message is the same as a protocol version associated with the second device in a memory of the first device. When the protocol version is not the same, it is determined if the protocol version of the message is a known protocol version; and the protocol version associated with the second device in the memory of the first device is updated when the protocol version is known. When the protocol version is the same, the message is processed at the first device.

Itoh discloses an ATM switch that accommodates a plurality of protocols. In the Office Action the Examiner refers to portions of Itoh regarding UNI identification, message analysis, and a memory of the switch in rejecting claims 1-16. However, while the message analyzer of Itoh analyzes a message from a first terminal by identifying a UNI for the first terminal, with regard to independent claims 1, 8 and 15, Itoh fails to disclose the performance of two separate determination steps: (i) determining if the protocol version of the at least one message is the same as a protocol version associated with the second device in a memory of the first device; and (ii) determining if the protocol version of the at least one message is a known protocol version when the protocol version of the at least one message is not the same. Further, the Examiner acknowledges that Itoh fails to

teach “updating the protocol version associated with the second device when the protocol version of the at least one message is known.”

The Examiner contends that Northcutt discloses those elements in the independent claims of the present invention that are not disclosed in Itoh. However, Northcutt discloses a method and apparatus for synchronizing firmware, such as versions of software, associated with a first and a second computer device, such as a server and a client computer. The synchronization of firmware of a second device with firmware of a first device as described in Northcutt, differs significantly from the updating of a message protocol version associated with a second device in a memory of a first device, as described in the independent claims of the present invention. Firmware is not updated in the first and second device of the independent claims of the present invention. Northcutt fails to disclose anything regarding devices and their stored associated message protocol versions and thus, also fails to disclose the two separate determining steps of the independent claims described above.

Further, with regard to claim 16, the combination of Itoh and Northcutt fails to disclose a first device that determines whether an extracted information identifier element from a message is valid for a protocol version associated with a second device in the memory of the first device.

Therefore, the collective teachings of Itoh and Northcutt fail to disclose the limitations of independent claims 1, 8, 15 and 16 as described above.

Second, Applicants assert, with respect to claims 1-16, that no motivation exists to combine Itoh and Northcutt in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. While both references generally relate to communicating devices, Applicants strongly believe that one ordinarily skilled in the art would not look to the methods of synchronizing firmware described in Northcutt to find inspiration to improve the ATM switch of Itoh, or vice versa. In fact, synchronization of firmware between two communicating devices (Northcutt) appears to teach away from the use of a switch capable of interworking between different UNIs in an ATM network (Itoh).

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su

Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344.

For example, in the Office Action, in paragraphs 4-5 on page 3, and paragraphs 2-3 on page 4, the Examiner provides the following statements to prove motivation to combine Itoh and Northcutt:

It would have been obvious . . . to employ the updating of firmware version as taught by Northcutt into Itoh to arrive the claimed invention as specified in claims 1 and 8.

The suggestion/motivation for doing so would have been to provide a same common protocol in order for the devices to communicate with each other.

and,

It would have been obvious . . . that the ATM switch 50 would be able to process the communicating message from the terminal A to a terminal B if they both have the same UNI version.

The suggestion/motivation for doing so would have been to provide an ATM switch capable of interworking between different UNIs in an ATM network.

Applicants submit that these statements of obviousness are conclusory, and based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provide insufficient support for an obviousness rejection. The Examiner also fails to identify any objective evidence of record which supports the proposed combination.

Lastly, with respect to claims 1-16, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Itoh and Northcutt. Contrary to the assertion made by the Examiner in the Office Action, Applicants respectfully submit that Itoh and Northcutt are not combinable since it is not clear how one would combine them to reach the claimed invention. Itoh is directed toward interworking between different UNIs and Northcutt is directed toward synchronization for interaction via a common protocol. No guidance was provided in the Office Action as to how the two references can be combined to achieve the present invention.

However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention, as described above.

Applicants assert that dependent claims 2-7 and 9-14 are patentable at least by virtue of their dependency on independent claims 1 and 8. Dependent claims 2-7 and 9-14 also recite patentable subject matter in their own right. For example, as described above with regard to independent claim 16, the combination of Itoh and Northcutt fails to disclose a first device that determines whether an extracted information identifier element from a message is valid for a protocol version associated with a second device in the memory of the first device, as also recited in independent claims 6 and 13.

In view of the above, Applicants believe that claims 1-16 are in condition for allowance, and respectfully request withdrawal of the §103(a) rejection.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert W. Griffith". The signature is fluid and cursive, with a large, stylized "G" at the end.

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Enclosure(s): Notice of Appeal